

REMARKS

Claims 1-14 and 16-21 are all of the pending claims, with claims 1, 18, and 20 being written in independent form. By virtue of this Amendment, Applicant cancels claim 15 without prejudice or disclaimer.

I. Claim Rejections on Prior Art Grounds:

The Examiner rejects:

1. claims 1, 11, 15 and 18-20 under 35 USC §103(a) as being obvious over US 5,044,372 to Anhäuser et al. (“Anhäuser”) in view of US 4,765,986 to Liedtke (“Liedtke”);
2. claims 2-4, 17 and 21 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of US 4,887,611 to Rüdiger et al. (“Rüdiger”);
3. claim 5 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of US 4,450,844 to Quisno (“Quisno”);
4. claim 6 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of US RE37,934 to Hoffmann (“Hoffmann”);
5. claim 7 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of US 4,543,964 to Breneman (“Breneman”);
6. claim 8 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of NL 8701577 to van der Bend (“van der Bend”);
7. claims 9, 12 and 13 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of US 4,472,507 to Pluim, Jr. (“Pluim”);
8. claims 10 and 14 under 35 USC §103(a) as being obvious over Anhäuser, Liedtke and Pluim, Jr., and further in view of US 4,158,359 to Kurokawa et al. (“Kurokawa”); and
9. claim 16 under 35 USC §103(a) as being obvious over Anhäuser and Liedtke, and further in view of US 4,809,707 to Kraft et al. (“Kraft”).

Applicant respectfully traverses all of these rejections in view of the following remarks.

II. Independent Claims 1, 18 and 20:

Each of independent claims 1, 18 and 20 recites (in different formats) that each test chamber includes (1) a first “*layer of adhesive*” (or “*adhesive means*”) provided on the frame-shaped foam plastic layer, and (2) a second “*layer of adhesive*” interposed between the frame-

shaped foam plastic layer and the support element. By way of example only, and with reference to Fig. 2, a first layer of adhesive 26 is provided on the outer side (or upper side) of the frame-shaped foam plastic layer 25. And a second layer of adhesive 22/23 is interposed between the frame-shaped foam plastic layer 25 and the support element 17. At least these features (as recited in each of independent claims 1, 18 and 20), in combination with the other features recited in independent claims 1, 18 and 20, are not taught or suggested by the prior art relied upon by the Examiner. Applicant discusses each feature separately below.

A. The First Layer of Adhesive:

The Examiner recognizes that Anhäuser is not pertinent to the claimed first “*layer of adhesive*” (or “*adhesive means*”), and therefore looks to Liedtke to allegedly teach this feature. In so doing, the Examiner relies upon a modification of Anhäuser that involves dispensing with the disclosed locking ring 15 in favor of Liedtke’s foam ring 10 and adhesive layer 11 (see Fig. 4) “*to achieve the predictable result of providing an alternative ... frame layer with additional adhesive to further adhere the plaster to skin.*”¹ This rejection position is not convincing for several reasons.

The Rejection Rationale is Incorrect

First, the Examiner’s characterization of the alleged modification as a *substitution of one known element for another* is incorrect. This is because the modification involves dispensing with only one element from Anhäuser (i.e., the locking ring 15) in favor of two elements from Liedtke (i.e., the foam ring 10 + the adhesive layer 11). That is, the alleged modification includes more elements than Anhäuser’s disclosed device. This is the hallmark of *combining prior art elements*, but not an indicia of a simple substitution of one part for another. Applicant’s position in this regard is consistent with the numerous and varied examples provided in the examination guidelines for determining obviousness under 35 USC §103 in view of the Supreme Court decision in *KSR International Co. v. Teleflex Inc.*²

¹ Office Action, paragraph 5.

² See, Federal Register, vol. 72, no. 195, p. 57526-57535, October 10, 2007.

The rationale to support a combination of prior art elements requires (among other things) that the prior art included each element claimed, with the *only difference* between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

In the situation at hand, the Examiner attempts to compare Liedtke's foam ring 10 to the claimed frame-shaped foam plastic layer. As shown in Fig. 4 of Liedtke, however, the foam ring 10 does *not* define "*at least some sidewalls of the test chamber that directly confront each other,*" as claimed. Indeed, the synthetic material disk 1 (positioned in foam ring 10) necessarily prevents any sidewalls of the foam ring 10 from directly confronting each other. This difference is significant because it is in addition to the lack of actual combination of the claim elements in a single reference (which is the *only difference* permitted by the rationale).

Applicant notes that claim 18 recites the adhesive layer in a *means-plus-function* format. Specifically, claim 18 requires "*adhesive means for attaching the frame-shaped foam plastic layer to a test area.*" In contrast, Liedtke teaches a *therapeutic device* for bringing medications into the body system of the patients. Accordingly, Liedtke's adhesive layer 11 is for attaching the device to a therapeutic area, not a "*test area*" as claimed. This difference in function is significant because it is in addition to the lack of actual combination of the claim elements in a single reference (which is the *only difference* permitted by the rationale).

The Primary Reference Teaches Away

Turning to the next point, the primary reference to Anhäuser would have led those skilled in the art directly away from the alleged modification. Specifically, and with reference to Fig. 1 of Anhäuser, the protective layer 16 "*must be*" removable from the remainder of the plaster with a force smaller than that required for removing the support film 11 from the carrier film 12.³ If Liedtke's adhesive layer 11 were incorporated (as alleged by the Examiner), then it would contact the protective layer 16 and necessarily increase the force required to remove the protective layer 16 from the plaster. This would interfere with (and possibly altogether defeat) the relative removal forces required by Anhäuser.

³ Anhäuser, col. 3, lines 33-37.

References Take Different Approaches:

Finally, the references take mutually exclusive paths and reach different solutions to practically and conceptually different problems. On the one hand, the primary reference to Anhäuser teaches a *diagnostic test device* including a receiving device 14 that is loaded with a test substance.⁴ The intended purpose of the device is to apply the test substance to a patient's skin. On the other hand, the secondary reference to Liedtke teaches a *therapeutic device* for bringing medications into the body system of the patients through a transdermal route. The two concepts (i.e., supplying a test substance to the skin *versus* bringing medications into the body) are fundamentally different, and therefore it would not be logical to combine the references in the manner suggested by the Examiner.

B. The Second Layer of Adhesive:

Applicant respectfully submits that none of the asserted references is relevant to the second layer of adhesive, which is "*interposed between the frame-shaped foam plastic layer and the support element*," as recited in each of independent claims 1, 18 and 20. For example, Anhäuser's locking ring 15 is secured to the remainder of the plaster via the adhesive layer 13 provided on the carrier film 12. But no adhesive layer (or any other element) is interposed between the locking ring 15 and the receiving device 14. Liedtke's device is no more relevant because no adhesive layer (or any other element) is interposed between the foam ring 10 and the synthetic material disk 1. Consequently, even if those skilled in the art were somehow motivated to combine the references in the manner suggested by the Examiner, the resultant device would still not meet each and every feature recited in independent claims 1, 18 and 20.

⁴ See Anhäuser, col. 1, lines 6-24.

CONCLUSION

In view of the above, Applicant earnestly solicits reconsideration and allowance of all of the pending claims.

The Commissioner is authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-4446 for any additional fees required under 37 CFR § 1.16 or under 37 CFR § 1.17; particularly, extension of time fees.

Respectfully submitted,

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